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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,398	03/01/2004	Roland Greubel	2860	5874

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EXAMINER

PICKETT, JOHN G

ART UNIT PAPER NUMBER

3728

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/790,398

Applicant(s)

GREUBEL, ROLAND

Examiner

Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) 20 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/1/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's election **without** traverse of Group I, claims 1-19 in the reply filed on 22 June 2006 is acknowledged. Claim 20 is withdrawn from further consideration as being directed to a non-elected invention.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. The effective filing date of the claimed invention appears to be 6 March 2003.

Oath/Declaration

3. Receipt is acknowledged of the applicant's new declaration filed 22 June 2006.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the superordinate unit of claim 1, the adhesive film of claim 10, and the adhesive strip of claim 14 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant's specification describes the superordinate unit as the item to which the rail is to be finally attached (see for example page 11, second paragraph), yet claim 1 recites "the component is attached by means of the at least one attachment element". It is unclear as to whether the superordinate unit is part of the claimed

Art Unit: 3728

package. To prosecute examination of the claim, the examiner assumes the following language in lines 2-3:

--the component may be attached by means of the at least one attachment element--.

Claims 2-19 are dependent on claim 1 and are rejected for the above reasons.

Claim 6 recites the limitation "the locking bar" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "the remaining part of the package" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the cover part" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the cover part" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitations "at least one floor part element" and "at least one cover part component" in line 2. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3728

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Mikels (US 5,437,368).

Claim 1: Insofar as the examiner can determine the scope of the claim, Mikels discloses at least one attachment element **14** held in a form-locking manner in a component **10** with an upper surface (portion near head of **14**), a bottom surface (bottom portions of **18**), and at least one mounting **13**, and is formed at least partially substantially rigidly. Mikels is capable of functioning as claimed.

7. Claims 1, 2, and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Yang (US 6,705,464).

Claim 1: Insofar as the examiner can determine the scope of the claim, Yang discloses at least one attachment element **3** held in a form-locking manner in a component **1** with an upper surface **12** a bottom surface **11** and at least one mounting **13**, and is formed at least partially substantially rigidly. Yang is capable of functioning as claimed.

Claims 2 and 7: Yang discloses locking bar **2**.that is separate from the remaining part of the package.

8. Claims 1, 3-5, 12, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Newton (US 572,061).

Claim 1: Insofar as the examiner can determine the scope of the claim, Newton discloses at least one attachment element **b** held in a form-locking manner in a component **a** (see Figures 4 and 5) with an upper surface, a bottom surface, and at least one mounting (apertures), and is formed at least partially substantially rigidly. Newton is capable of functioning as claimed.

Claims 3-5: Newton discloses a cover part **3 & 2** and a floor part **5 & 6** that are arranged to cover at least a part of the lateral sides.

Claim 12: Newton discloses open ends, which are considered open mountings.

Claim 16: Newton discloses identical side flaps **6** on the floor part and identical side flaps **2** on the cover part.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 3728

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newton in view of Official Notice.

Newton, as applied to claim 3 above, discloses the claimed invention except for the adhesive strips. Official Notice is taken that the use of adhesive strips (i.e. packing tape, SCOTCH tape, etc.) to secure a packaging box was known in the art at the time the invention was made and the provision of such tape to secure the cover part to the floor part would have been obvious to one of ordinary skill in the art.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newton.

Extruded plastic was a known material at the time the invention was made. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the package of Newton from an extruded plastic, since has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

11. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newton in view of Macaluso (US 4,976,374).

Newton, as applied to claim 3 above, discloses the claimed invention except for the end caps. Newton has open ends.

Macaluso teaches end caps **14** to close the ends of a packing container **12**, and for said purpose it would have been obvious to one of ordinary skill in the art to provide the package of Newton with end caps.

As to the material, injection molded plastic was a known material at the time the invention was made. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the package of Newton-Macaluso from an injection molded plastic, since has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

12. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yang.

Claim 19 invokes the provisions of 112, 6th paragraph, and according to the applicant's specification, the means for protecting the component can be either of a corrosion-protecting paper or by using an out-gassed plastic. Out-gassed plastic was a known material at the time the invention was made. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the package of Yang from an out-gassed plastic, since has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Allowable Subject Matter

13. Claims 6, 8-11, and 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

14. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Greg Pickett
Examiner
15 September 2006